

REMARKS

Claims 8-13, 17, and 28-49 are pending in the present application. By this Amendment, the specification is amended; and previously presented claims 8, 13, 17, 28 and 37 are amended. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendment and the following remarks.

I. Formal Matters:

Priority Claim:

The first paragraph of the present specification has been amended as shown above to clarify that the present application is a divisional patent application relating to parent patent application U.S. Patent Application Serial No. 09/496,831, filed on February 2, 2000, now U.S. Patent No. 6,630,531.

Objection To Specification:

Previously presented claims 8, 13, 17 and 37 have been amended as shown above to remove the “midblock-compatible tackifier” from the claims. Applicants note that although the original specification does not literally describe suitable tackifiers as being “midblock-compatible tackifiers,” the original specification implicitly provides support for this claim language. For example, on page 15, lines 28-31 of the original specification, it is disclosed:

As used herein, a tackifier is one that typically has a higher T_g than the rubber phase T_g of the particular polymodal asymmetric elastomeric block copolymer being used **and the addition of the tackifier increases the T_g of the rubber phase of the adhesive composition.** (Emphasis added.)

It is respectfully submitted that a tackifier that increases the T_g of the rubber phase (e.g., the “midblock”) of the adhesive composition has to be a “midblock-compatible” tackifier. Otherwise, addition of the tackifier would have very little or no effect on the T_g of the rubber phase of the adhesive composition. Further, calculation of the glass transition temperature, T_g , of the pressure-sensitive adhesive according to the Fox equation is based on the miscibility of the tackifier into the rubbery phase of the adhesive composition (e.g., the compatibility of the tackifier with the “midblock” of rubber phase of the adhesive). See, page 16, lines 28-31 of the original

specification.

It should be further noted that explicit, literal support for the language used in claims is not required in order to meet the written description requirements of §112. As stated by the Court, “If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.” See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”).

It should be even further noted that the term “midblock-compatible tackifier” was used in the allowed claims of parent application U.S. Patent Application Serial No. 09/496,831 (now U.S. Patent No. 6,630,531), which was examined and allowed by Examiner Szekely.

For at least the reasons given above, it is respectfully submitted that the phrase “midblock-compatible” tackifier is implicitly supported in the original specification. However, in order to facilitate prosecution of the present application, claims 8, 13, 17 and 37 have been amended as shown above to instead recite that the “at least one tackifier” is “capable of increasing the T_g of the rubber phase of the adhesive.” Withdrawal of the objection to the specification is respectfully requested.

Claim Rejections Under 35 U.S.C. §112, First Paragraph:

Previously presented claim 28 was rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement. The claim allegedly contained subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As shown above, Applicants have removed the language objected to by Examiner Szekely, namely, “a polymer suitable for melt extrusion processing.”

For at least the reasons given above, Applicants respectfully submit that claim 28, and the remaining presently presented claims, meet the enablement requirement of 35 U.S.C.

§112, first paragraph. Accordingly, withdrawal of the rejection of claim 28 under 35 U.S.C. §112, first paragraph is respectfully requested.

Provisional Obviousness-Type Double Patenting Rejection

Previously presented claims 8-13, 17 and 28-49 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21-22 of co-pending U.S. Patent Application Serial No. 10/868,480. Since the presently presented claims and the claims of co-pending U.S. Patent Application Serial No. 10/868,480 are still pending, Applicants respectfully submit that further action at this time is unwarranted. However, Applicants will consider filing a terminal disclaimer in the present application and/or co-pending U.S. Patent Application Serial No. 10/868,480 as necessary to avoid the possibility of double patenting.

II. Prior Art Rejections:

Rejection of Previously Presented Claims 8-13, 17 and 28-49 Under 35 U.S.C. §103(a) In View Of Nestegard'506 In Combination With Nestegard'787

Previously presented claims 8-13, 17 and 28-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,773,506 (hereinafter "Nestegard'506") in view of U.S. Patent No. 5,393,787 (hereinafter "Nestegard'787"). This rejection is respectfully traversed.

Applicants respectfully submit that the proposed combination of the teaching of Nestegard'506 with the teaching of Nestegard'787, even if proper, fails to teach, disclose or suggest Applicants' claimed invention as recited in claims 8-13, 17 and 28-49. The proposed combination of the teaching of Nestegard'506 with the teaching of Nestegard'787, even if proper, fails to teach, disclose or suggest (1) an adhesive comprising at least one tackifier capable of increasing the T_g of the rubber phase of the adhesive, wherein the at least one tackifier is present in an amount sufficient to raise the calculated Fox T_g of a rubber phase of the adhesive to greater than 245°K, and (2) an adhesive layer that exhibits a 180° peel adhesion on high density polyethylene of at least 80 N/dm.

Regarding the proposed combination, Examiner Szekely states the following from page 4, line 21 to page 5, line 6 of the December 08, 2005 final Office Action:

Nestegard et al. ('506) disclose applicants' copolymer in Examples 2 and 3. The glass transition temperature of the tackified polyisoprenes fraction is about 245°K, which overlaps "greater than 245°K". The adhesive containing midblock-compatible tackifiers is "Adhesive 11" in Table 6. Tapes, backings, foaming, etc. is shown in the paragraph overlapping columns 6 and 7. Nestegard et al ('787) teach applicants' adhesive in claims 1-6 and 19-25, backing and crosslinking in claims 7-18 and state in the paragraph overlapping columns 5 and 6 that the backing sheet can be any suitable material. Accordingly, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to select a midblock compatible tackifier system and any suitable backing including foam backing for the tapes using applicants' adhesive.

Applicants disagree.

It should be noted that the teaching of Nestegard'506 does not disclose a tackified polyisoprene fraction having a glass transition temperature greater than 245°K as suggested by Examiner Szekely in the above cited statement. Example 3 of Nestegard'506 specifically discloses:

the resulting tackified adhesive had an estimated glass transition temperature of about 245° K for the tackified polyisoprene fraction of the adhesive as predicted by the Fox equation.

In parent application U.S. Patent Application Serial No. 09/496,831 (now U.S. Patent No. 6,630,531), Applicants submitted a signed August 08, 2002 Declaration Under 37 C.F.R. §132 from Jingjing Ma, an inventor in the present invention and both Nestegard'506 and Nestegard'787, to specifically show that the tackified polyisoprene fraction of the copolymer described in Example 3 of Nestegard'506 does not disclose a glass transition temperature greater than 245°K. (A copy of the August 08, 2002 Jingjing Ma Declaration is attached.) As stated in paragraph 9 of the Jingjing Ma Declaration, the copolymer described in Example 3 of Nestegard'506 has a glass transition temperature of 243.2°K.

The Jingjing Ma Declaration also describes the differences between the adhesives of the present invention and the adhesives disclosed in Nestegard'506 and Nestegard'787. As

specifically noted in the Jingjing Ma Declaration, the adhesives disclosed in Nestegard'787 (1) do not disclose adhesives having a rubber phase with a Fox T_g value of greater than 245°K (paragraphs 6 and 8); (2) are not designed to provide a high strength bond to low energy surfaces like the adhesives of the present invention (paragraph 7); and (3) exhibit a 180° peel adhesion on high density polyethylene of about 50.1 N/dm (paragraph 8). The Jingjing Ma Declaration further states that the adhesives disclosed in Nestegard'506 (1) do not disclose adhesives having a rubber phase with a Fox T_g value of greater than 245°K (paragraph 9); (2) are designed to provide moderate adhesion and clean removability, not to bond to low energy surfaces like the adhesives of the present invention (paragraph 10); and (3) exhibit a 180° peel adhesion on high density polyethylene of about 30.2 N/dm (paragraph 12).

To further support the evidence described in the Jingjing Ma Declaration and to describe the differences between the adhesives of the present invention and the adhesives disclosed in Nestegard'506 and Nestegard'787, Applicants previously submitted a second signed August 08, 2002 Declaration Under 37 C.F.R. §132 (previously submitted in the parent application U.S. Patent Application Serial No. 09/496,831) from Ashish Khandpur, an inventor in the present invention. (A copy of the August 08, 2002 Ashish Khandpur Declaration is attached.) As specifically noted in the August 08, 2002 Ashish Khandpur Declaration, the adhesives disclosed in Nestegard'787 do not disclose adhesives having a rubber phase with a Fox T_g value of greater than 245°K (paragraphs 6 and 7). The August 08, 2002 Ashish Khandpur Declaration further states that the adhesives disclosed in Nestegard'506 (1) do not disclose adhesives having a rubber phase with a Fox T_g value of greater than 245°K (paragraph 8); and (2) exhibit a 180° peel adhesion on high density polyethylene of 30.2 N/dm (paragraph 9).

To further describe the differences between the adhesives of the present invention and the adhesives disclosed in Nestegard'506 and Nestegard'787, Applicants previously submitted a third signed January 28, 2003 Declaration Under 37 C.F.R. §132 (previously submitted in the parent application U.S. Patent Application Serial No. 09/496,831) from Ashish Khandpur. (A copy of the January 28, 2003 Ashish Khandpur Declaration is attached.) As specifically noted in the January 28, 2003 Ashish Khandpur Declaration, the adhesives disclosed

in Nestegard'787 (1) have a much lower 180° peel adhesion to stainless steel (i.e., from about 28 to 77 N/dm) compared to the adhesives of the present invention (i.e., from about 151.4 to 206.5 N/dm) (paragraph 4); and (2) do not disclose adhesives having a rubber phase with a Fox Tg value of greater than 245°K and exhibiting a 180° peel adhesion on high density polyethylene of at least 80 N/dm (paragraphs 7 and 8). The January 28, 2003 Ashish Khandpur Declaration further states that the adhesives disclosed in Nestegard'506 do not disclose adhesives having a rubber phase with a Fox Tg value of greater than 245°K and exhibiting a 180° peel adhesion on high density polyethylene of at least 80 N/dm (paragraphs 13 and 14).

Given the teachings of Nestegard'506 and Nestegard'787 and the evidence supplied in the Jingjing Ma Declaration, the August 08, 2002 Ashish Khandpur Declaration and the January 28, 2003 Ashish Khandpur Declaration, Applicants respectfully submit that the proposed combination of the teaching of Nestegard'506 with the teaching of Nestegard'787 fails to teach, disclose or suggest Applicants' claimed invention as recited in claims 8-13, 17 and 28-49. The proposed combination of the teaching of Nestegard'506 with the teaching of Nestegard'787 fails to teach, disclose or suggest an adhesive having a rubber phase Fox Tg greater than 245°K that also exhibits a 180° peel adhesion on high density polyethylene of at least 80 N/dm. Accordingly, withdrawal of this rejection is respectfully requested.

III. Conclusion:

For at least the reasons given above, Applicant submits that claims 8-13, 17, and 28-49 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

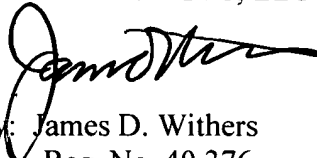
Should Examiner Szekely believe that further action is necessary to place the application in better condition for allowance, Examiner Szekely is respectfully requested to contact Applicants' representative at the telephone number listed below.

Amendment And Response
Serial No. 10/610,950

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Respectfully submitted,

WITHERS & KEYS, LLC


By: James D. Withers
Reg. No. 40,376

WITHERS & KEYS, LLC
18 Atlanta Street
McDonough, Georgia 30253
678-565-4748

W&K Matter No.: 10002.0147US01
3M Matter No.: 55347US020